

AMENDMENT TO THE DRAWING(S)

The attached six (6) sheets of formal drawings replaces the original six (6) sheets including Figs. 1-10.

REMARKS/ARGUMENTS

Claims 3-16 and 19-22 are pending in the instant application. Applicant kindly requests favorable reconsideration.

Amendments to the Claims

Claims 1-2 and 17-18 are cancelled without disclaimer or prejudice to the subject matter thereof, nor to their subsequent reintroduction in this or a continuing application. Independent claim 15 is amended to clarify the structure of the back side of the rack, consistent with the disclosure thereof in the specification and drawings, for example at p. 14, among other places.

New claim 23 depends from claim 15, and finds support generally throughout the original specification as filed, for example at Figs 9-10 and their respective accompanying description.

Claims 3-5 and 9-11, previously dependent upon claim 1, are amended to depend from independent claim 15.

The claims are also amended in response to the rejections under 35 U.S.C. § 112, as described in more detail below. No new matter has been added.

Drawings

The drawings were objected to for failure to show a “back pressure face” as recited in the claims, and also for line quality. In response to the latter objection first, submitted herewith are replacement drawings sheets with redrafted Figs. 1-10. The “back pressure face” recited in independent claims 1 and 13 is described in the specification, for example at p. 1. However, without prejudice or disclaimer, this phrase is deleted from claim 13 by the above amendment. No new matter has been added.

Favorable reconsideration and withdrawal of the objection is kindly requested.

Rejection Under 35 U.S.C. § 112

Claims 1-14 and 17-20 are rejected under 35 U.S.C. § 112, first paragraph, as lacking an enabling disclosure to support the features of a “back pressure face” and “bearing faces on the third side” as recited in those claims.

As noted in response to the drawing objection above, the “back pressure face” recited in independent claim 13 is described in the specification, for example at p. 1. However, without prejudice or disclaimer, this phrase is deleted from claim 13 by the above amendment.

With regard to the “bearing faces on the third side [of the rack]”, the specification provides, for example at p. 10, “The rack 4 is of Y-shaped configuration and has two bearing faces 4.1, 4.2 which are inclined symmetrically at an angle with respect to the toothing plane of the pinion 3.1 and the rack 4.” The feature is also supported elsewhere in the specification. Therefore, Applicant respectfully submits that the feature has ample support in the specification, and kindly requests favorable reconsideration and withdrawal.

Unspecified claims are rejected under 35 U.S.C. § 112, second paragraph, for grammatical errors and indefinite language. Applicant respectfully traverses.

The rejection is unclear, in that it does not designate the claims rejected, nor point out all alleged errors or indefinite language. Applicant also notes that the claims were amended by Preliminary Amendment to place them in improved form for U.S. examination. However, in the interest of advancing prosecution, the noted deficiencies are addressed as follows.

Claim 13 recites “the rack having a third side” immediately before the objected phrase “bearing faces on the third side”. However, without prejudice to the rejection, for clarification only and not limiting the scope of the claims beyond the previously presented scope, the claims are amended to recite “and bearing faces on the third side of the rack,” (underline per 37 C.F.R. § 1.121). Favorable reconsideration and withdrawal of the rejection is kindly requested.

The Office Action objects to “at each bearing face” as unclear for failure to specify which of the five bearing faces referenced. Applicant respectfully submits that the term “each” adequately addresses the expressed concern. For example, the American Heritage Dictionary defines “each” in the adjective form as “Being one of two or more considered individually; every.”¹ Therefore, Applicant respectfully submits that “at each bearing face” means only what one of ordinary skill in the art would take the phrase to mean, in light of the instant specification, that is, every. Favorable reconsideration and withdrawal of the rejection is kindly requested.

¹ Dictionary.com. The American Heritage® Dictionary of the English Language, Fourth Edition. Houghton Mifflin Company, 2004. <http://dictionary.reference.com/browse/each> (accessed: August 11, 2008).

The Office Action objects to “respective pressure piece” as indicating more than one pressure piece. This objection is moot in light of the cancellation of claim 1. Favorable reconsideration and withdrawal of the rejection is kindly requested.

The Office Action objects to the “the other rotatable runner plate” as lacking antecedent basis. Without prejudice to the rejection, by the above amendment, Applicant has deleted “rotateable” from the claim, and therefore the antecedent basis in the “other runner plate” is found in the earlier recitation of “comprising two spaced apart runner plates... one runner plate... and the other runner plate...” Favorable reconsideration and withdrawal of the rejection is kindly requested.

The Office Action object to the term “with respect to the bearing face” as not being clear which bearing face is in question. Applicant respectfully submits that the roller bearing recited is at “each bearing face” (see above), and therefore not at all unclear. However, without prejudice to the rejection, by the above amendment the claims are recited to recite “with respect to the respective bearing face” (underline per 37 C.F.R. § 1.121). Favorable reconsideration and withdrawal of the rejection is kindly requested.

The amendments made above are for clarification only, and do not alter the scope of their respective claims from the claims as previously presented. Accordingly, the amendments are merely tangential to the merits of the respective claims. No new matter has been added by the amendments.

Rejection Under 35 U.S.C. § 103

Claims 1-6 and 8-22 are rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,736,021 to Adams (“Adams”) in view of U.S. Patent No. 6,948,401 to Zernickel, *et al.* (“Zernickel ‘401”), or International Patent Application Publication WO 02/064989 based upon the same priority as Zernickel ‘401. Claim 7 is rejected under rejected under 35 U.S.C. § 103(a) as obvious over Adams in view of Zernickel ‘401, and further in view of U.S. Patent No. 3,433,543 to Eck (“Eck”). Applicant respectfully traverses the rejections.

Independent claim 13 recites a rack and pinion steering system for a motor vehicle, comprising “at least one axial sliding bearing, at each bearing face”, referring to the previously recited “bearing faces on the third side of the rack”. These features are neither taught nor suggested by the cited references, nor are they addressed in the Office Action.

For example, Adams discloses exclusively rolling bearings (144, 156), not an axial sliding bearing as recited in claim 13. Moreover, the Office Action suggests that it would be obvious to replace the bearing of Adams with the bearing disclosed in Zernickel '401. However, Zernickel '401 discloses only axial roller bearings, not an axial sliding bearing, as recited in claim 13. Even presuming, *arguendo*, that there were some apparent reason to combine the references as proposed in the Office Action, their combination does not teach or suggest all limitations of claim 13. It is well-settled that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Therefore, Applicant respectfully submits that claim 13 is patentably distinguished over Adams and Zernickel '401, taken singly or in combination.

Claims 14 and 19-20 each depend, either directly or indirectly, from independent claim 13. These dependent claims are each separately patentable, but in the interest of brevity, they are offered as patentable for at least the same reasons as their underlying independent base claim the features of which are incorporated by reference. Therefore, Applicant respectfully submits that the rejection of claims 13-14 and 19-20 has been obviated, and kindly requests favorable reconsideration and withdrawal.

Independent claim 15 recites a rack-and-pinion steering system for a motor vehicle comprising, *inter alia*, "the rack having a back side which lies opposite the second contact surface thereof, the back side having an arcuate form". This feature is neither taught nor suggested in Adams, nor is it addressed in the Office Action. More specifically, Adams teaches precisely away from this feature of claim 15, where it recites "The first and second contact surfaces 50 and 52 of the lower portion 40 of the rack bar 34 are flat." (Col. 3, lines 29-31). This deficiency of Adams is not ameliorated by the proposed combination with Zernickel '401, which proposes to incorporate the axial roller bearings disclosed therein. Therefore, Applicant respectfully submits that independent claim 15 is patentably distinguished over Adams and Zernickel '401, taken singly or in combination.

Claims 3-12, 16 and 21-23 each depend, either directly or indirectly, from independent claim 15. These dependent claims are each separately patentable, but in the interest of brevity, they are offered as patentable for at least the same reasons as their underlying independent base claim, the features of which are incorporated by reference. Therefore, Applicant respectfully

submits that the rejection of claims 3-12, 15-16 and 21-22 has been obviated, and kindly requests favorable reconsideration and withdrawal.

Turning to claim 7, this claim also depends from independent claim 15, and incorporates the features thereof by reference. The Office Action offers Eck as teaching a cage to provide a bearing that can accommodate small swinging movement of the parts without pitting. Even presuming that Eck teaches what is attributed to it, and further presuming that there is some apparent reasons to combine the references as proposed in the Office Action, the addition of Eck to Adams and Zernickel does not ameliorate the deficiencies of either with respect to underlying independent base claim 15, as noted above. Therefore, Applicant respectfully submits that claim 7 is patentably distinguishable over Adams, Zernickel '401 and Eck, taken singly or in any combination.

Conclusion

In light of the foregoing, Applicant respectfully submits that all claims are allowable, and that the application is in condition for issue.

THIS CORRESPONDENCE IS BEING
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Respectfully submitted,



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